Shelby County Health Care Corp v Southern Council of Indus Workers,
203 F 3d 926 (6th Cir 2000) 7

Sira v Morton,
380 F 3d 57 (2d Cir 2004) 3

Three Boys Music Corp v Bolton,
212 F 3d 477 (9th Cir 2000) 10

Underwood v Hunter,
604 F 2d 367 (5th Cir 1979) 6

Winfrey v Brewer,
570 F 2d 761 (8th Cir 1978) 6

Rules

Fed R Civ P 12(b)(6) *passim*
Fed R Civ P 56 *passim*
Fed R Civ P 56(c) *passim*
Fed R Civ P 56(f) 9, 10

Other Authorities

Statement by Tim Kring – NBC's "creator" of "Heroes," (posted on internet December 4, 2007), Appendix O to Petition for Certiorari (http //blog the-cg com/2007/12/04/tim-kring/) 9

RELEVANT PROVISIONS INVOLVED

Fed R Civ P 56 Summary Judgment

* * *

(c) SERVING THE MOTION, PROCEEDINGS The motion must be served at least 10 days before the day set for the hearing An opposing party may serve opposing affidavits before the hearing day The judgment sought should be rendered if the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law

STATEMENT OF THE CASE

Petitioners Clifton Mallery a/k/a Enjai Omaa Eele and Amnau Karam Eele respectfully seek rehearing of the order denying a writ of certiorari to resolve an important split in the Circuit Courts on an important issue of federal law that was not previously presented in Petitioners' Petition for Grant of a Writ of Certiorari That important issue is

Whether Fed R Civ P Rule 56 and the Due Process Clause require that a nonmovant be given prior notice, in accordance with the notice requirements of Fed R Civ P Rule 56(c), before a motion under Fed R Civ P Rule 12(b)(6) is converted to one under Rule 56, or whether a trial judge may do so by converting the Rule 12(b)(6) to one under Rule 56 and simultaneously entering judgment, without providing prior notice, an issue upon which the Circuits are split

As shown below, the Circuit Courts of Appeals are split on this important issue The majority of Circuits have a "bright line" rule mandating such prior notice in all cases (a rule submitted to be correct) Some Circuits (including the Second Circuit, which decided the appeal that is the subject of this petition for rehearing) hold that although such advance notice "should" be given, it need not be in all cases The resolution of this issue is controlling of the outcome of Petitioners' appeal of the grant of summary judgment against them, since such summary judgment was granted against them without the required notice Furthermore, because Rule 12(b)(6) motions are ubiquitous in federal practice, resolution of this split by the Court is of enormous practical importance to the entire federal bench and bar

1. The District Court Proceedings

On June 15, 2007, defendant NBC, in response to Petitioners' Complaint alleging claims for copyright infringement, in lieu of an answer, filed a motion to dismiss in the district court pursuant to Fed R Civ P 12(b)(6) NBC attached copies of the copyrighted works, some episodes of the accused "Heroes" television show to its motion, and also relied on an Affidavit of Koonce, which included a variety of exhibits allegedly showing "scenes a faire" In its motion, NBC admitted having access to the Petitioners' copyrighted works However, NBC argued that a comparison of the allegedly infringed and infringing works referenced in the complaint showed no substantial similarity of protectable expression

On August 2, 2007, Petitioners responded to the Rule 12(b)(6) motion, citing only cases pertinent to Rule 12(b)(6), and showing that substantial similarity did exist Petitioners also objected to NBC's presentation of the Koonce Affidavit and exhibits as being beyond the scope of a Rule 12(b)(6) motion On September 7, 2007, NBC served a Reply

On December 3, 2007, the district court issued its decision, simultaneously converting NBC's motion to dismiss under Rule 12(b)(6) into a motion for summary judgment under Rule 56 and granting summary judgment against Petitioners *Mallery v NBC Universal, Inc* , No 07 Civ 2250, 2207 WL 458196 (S D N Y Dec 3, 2007), *aff'd*, 331 Fed Appx 832 (2d Cir 2009) The district court provided no prior notice of such intended conversion However, the district court acknowledged in a footnote that "[a] district court must ordinarily give notice to the parties before converting a motion to dismiss to a motion for summary judgment," citing *Kopec v Coughlin*, 922 F 2d 152, 154-55 (2d Cir 1991) See *Mallery v NBC Universal, Inc* , No 07 Civ 2250, 2207 WL 458196 (S D N Y Dec 3, 2007), aff'd, 331 Fed Appx 832 (2d Cir 2009) Relying upon the Second Circuit holding in *Sira v Morton*, 380 F 3d 57, 68 (2d Cir 2004), the district court held that "[a] party is deemed to have notice that a motion may be converted if that party should reasonably have recognized the possibility that such a conversion would occur " (citation omitted) The district court determined that, "[g]iven the arguments raised by the parties (as well as the cases cited, which almost exclusively resolve such arguments on motions for summary judgment), the parties should have reasonably recognized that the instant motion could be converted to one for summary judgment " *Id*

2. The Second Circuit Court of Appeals Proceedings

On June 3, 2008, in a summary decision, the Second Circuit Court of Appeals affirmed *Mallery v NBC Universal, Inc* , 331 Fed Appx 821, 2009 WL 1532494 (2d Cir 2008)

REASONS FOR GRANTING THE PETITION

It is respectfully submitted that the Second Circuit's rule that notice "should" be given prior to conversion of a Rule 12(b)(6) motion to dismiss to a Rule 56 motion for summary judgment, but need not be in all cases, does not comport with the requirements of Rule 56(c) It is also respectfully submitted that decisions of this Court on a similar issue of notice relating to *sua sponte* Rule 56 motions, show that actual notice is *required*, not optional *See Celotex Corp v Catrett*, 477 U S 317, 326, 106 S Ct 2548, 2554 (1986) ("district courts are widely acknowledged to possess the power to enter summary judgments *sua sponte, so long as the losing party was on notice that she had to come forward with all of her evidence* ") (emphasis added) Under *Celotex*, it is submitted that the Second Circuit rule that actual notice "should" be provided, but need not be in all cases, is insufficient

In contrast to the permissive rule of the Second Circuit, the Eleventh Circuit properly requires that if the court is going to convert the 12(b)(6) to a summary judgment, express notice *must* be given

> It is within the judge's discretion to decide whether to consider matters outside of the pleadings that are presented to the court

> *Property Management & Investments, Inc v Lewis*, 752 F 2d 599, 604 (11th Cir 1985) However, if the judge does consider these outside matters, *i e*, if the judge does not exclude them, Rule 12(b) requires the judge to comply with the requirements of Rule 56 *Carter v Stanton*, 405 U S 669, 671, 92 S Ct 1232, 1234, 31 L Ed 2d 569, 572 (1972), *vacated on other grounds, sub nom Samkowski v Carter*, 416 U S 918, 94 S Ct 1916, 40 L Ed 2d 276 (1974) Rule 56 states, in relevant part, that a "motion [for summary judgment] shall be served at least 10 days before the time fixed for the hearing" Thus, the court must give the parties ten days notice that it is converting the moving party's motion to dismiss into a motion for summary judgment *Griffith v Wainwright*, 772 F 2d 822, 825 (11th Cir 1985) (and cases discussed therein)

Jones v The Automobile Insurance Company of Hartford, 917 F 2d 1528, 1531-2 (11th Cir 1990) *See also, Milburn v United States*, 734 F 2d 762, 766 (11th Cir 1984) ("'bright-line' test requiring 10-day advance notice that the court will take a motion for summary judgment under advisement as of a certain date"), *Finn v Gunter*, 722 F 2d 711, 713 (11th Cir 1984) ("This circuit has consistently upheld the strict notice requirements of rule [ ] 56(c)"), *Moore v State of Florida*, 703 F 2d 516, 519-20 (11th Cir 1983) ("Generally, 'the 10-day notice requirement of Rule 56(c) is strictly enforced'"), *Herron v Beck*, 693 F 2d

125, 126 (11th Cir 1982) (""ten-day notice requirement of Rule 56(c) is strictly enforced ") [1]

The same strict notice requirement is also followed by the Federal, the Third, the Fifth, the Eighth and the Tenth Circuits *See, Selva & Sons, Inc v Nina Footwear, Inc* , 705 F 2d 1316, 1322 (Fed Cir 1983) (when court converts Rule 12(b)(6) motion to motion for summary judgment, Rule 56 strictures of notice must be adhered to), *Davis Elliott International, Inc v Pan American Container Corp* , 705 F 2d 705, 707-08 (3d Cir 1983) (adopting rule of strict adherence to Rule 56 notice requirements when Rule 12(b)(6) motion is converted), *Estate of Smith v Tarrant County Hospital District*, 691 F 2d 207, 208 (5th Cir 1982) ("This circuit has consistently interpreted the terms of Rule 56 strictly and has refused to dispense with the procedural safeguards of notice and hearing "), *Underwood v Hunter*, 604 F 2d 367, 369 (5th Cir 1979) ("Subsequent cases have reaffirmed our adherence to

---

[1] The version of Rule 56 in effect at the time the district court converted the Rule 12(b)(6) motion to one under Rule 56 in the present case provided, in pertinent part "The motion must be served at least 10 days before the day set for the hearing " (Emphasis added) The portion of Rule 56(c) providing that "[t]The motion must be served at least 10 days before the day set for the hearing" has been amended in the current, 2010 version of Rule 56 to provide that "a party opposing the motion must file a response within 21 days after the motion is served " Rule 56(c) (2010) Accordingly, although the manner of counting days from the time the Rule 56 motion is "served" has been changed, the essential requirement that the nonmovant be given advance notice that a motion for summary judgment is pending against him or her to trigger the obligation to respond or the ability of the court to rule on the motion is common to both the 2008 version of Rule 56 and the current 2010 version

the strict notice and hearing requirements of Rules 12(b) and Rule 56 where the court sua sponte converts a 12(b)(6) motion into a summary judgment motion by considering matters outside the pleadings "), *Winfrey v Brewer*, 570 F 2d 761, 764 (8th Cir 1978) ("the required notice cannot be dispensed with merely because a motion to dismiss is treated as a motion for summary judgment"), *Adams v Campbell County School District*, 483 F 2d 1351, 1353 (10th Cir 1973) (noncompliance with ten day notice requirement of Rule 56 deprives court of authority to grant summary judgment)

Other Circuits have disparate holdings concerning whether conversion of Rule 12(b)(6) motions to motions for summary judgment requires notice Many, like the Second Circuit, do not provide a firm requirement of notice prior to conversion

The Fourth Circuit has held that if a party is 'aware' that material outside the pleadings is before the court, that is sufficient *Gay v Wall*, 761 F 2d 175 (4th Cir 1985) In the Sixth Circuit, whether a district court must provide actual notice that it intends to convert a motion to dismiss into a motion for summary judgment depends on the facts and circumstances of each case, where one party is likely to be surprised by the proceedings, notice is required *Shelby County Health Care Corp v Southern Council of Indus Workers*, 203 F 3d 926 (6th Cir 2000) In the Ninth Circuit, *Portland Retail Druggists Assn v Kaiser Foundation Health Plan*, 662 F 2d 641 (9th Cir 1981), simply being aware that "specific papers" were filed and having a reasonable opportunity to respond was sufficient Explicit notice of a *sua sponte* summary judgment is only required when the nonmoving party

is appearing *pro se* *Garaux v Pulley*, 739 F 2d 437, 439-40 (9th Cir 1984)

It is respectfully submitted that only the Majority "bright line" rule – requiring ten days notice in all cases -- complies with the language of Rule 56(c), the requirements of Due Process to provide notice and an opportunity to be heard, and is consistent with this Court's holding in *Celotex Corp v Catrett*, 477 U S 317, 106 S Ct 2548

In the present case, the failure to accord Petitioners the notice required by Rule 56(c), prior to conversion of the Rule 12(b)(6) motion to one for summary judgment under Rule 56, and the simultaneous grant of summary judgment was not harmless In particular, after briefing on Rule 12(b)(6) motion was closed and one day after the district court's December 3, 2009, grant of summary judgment, which occurred simultaneously with the district court's conversion of the Rule 12(b)(6) motion to a Rule 56 summary judgment motion, the following statement by NBC's Tim Kring – the supposed "creator" of "Heroes," was posted on the internet Mr Kring stated, in part, the following about how he "created" "Heroes"

> In Hollywood they say if Hitler wrote a great screenplay they'd send a limo to the airport to pick him up -Great creativity comes from everywhere, I was flubbed [before] and I didn't just want a show on the air, I wanted something big, bold, and wanted to prove them wrong Only problem was I didn't have an idea, so I was just left angry and worried about it I lied and cheated and schemed and manipulated all the way through the idiocy that is the notes

> process when you do this, was able to push the production through relatively unscathed and in the form that it would work in That's how Heroes got on the air It's not the most original idea in the world, you build and borrow Just put these pieces together in the right way, at the right time, and on the right network

Statement by Tim Kring – NBC's "creator" of "Heroes," (posted on internet December 4, 2007), Appendix O to Petition for Certiorari (http //blog the-eg com/2007/12/04/tim-kring/)

It is respectfully submitted that the foregoing admissions by Mr Kring, including that that he "lied, cheated and schemed and manipulated" to "create" the accused "Heroes" show would have been sufficient to defeat summary judgment Had the district court followed the requirement of Rule 56(c) to give ten days notice, the foregoing admissions by Mr Kring would have been available to Petitioners during that ten days period

Rule 56 includes other safeguards that were denied to Petitioners because of the lack of notice that the Rule 12(b)(6) motion was, in fact, being converted to a Rule 56 motion for summary judgment until judgment was already rendered For example, Rule 56(f) provides that

> "(f) When Affidavits Are Unavailable
>
> If a party opposing the motion shows by affidavit that, for specified reasons, it cannot present facts essential to justify its opposition, the court may

(1) deny the motion,

(2) order a continuance to enable affidavits to be obtained, depositions to be taken, or other discovery to be undertaken; or

(3) issue any other just order

With the safeguards afforded by Rule 56(f), Petitioner would have had the right to request a continuance to permit it time to take Mr Kring's deposition, and others, and to secure any other affidavits or other evidence deemed necessary to respond Petitioners were unable to do so, however, because the conversion of the Rule 12(b)(6) motion to one for summary judgment occurred simultaneously with grant of summary judgment, without any prior notice

In addition, had Petitioners' been accorded the ten days notice required by Rule 56(c), a strict requirement in the Majority but not in the Second Circuit, Petitioner's could also have sought to introduce expert testimony by Ms Joann Vara, whose statement appears in the Appendix B to Petitioners' reply in support of Petitioners' petition for certiorari As a professional in the field of "Clearance," Ms Vara is an expert in knowing what "ordinary observers" (i e , the viewing audience) consider "substantially similar" so that such "substantial similarity" will be avoided Such expert testimony would have been material evidence in opposing the motion for summary judgment *Three Boys Music Corp v Bolton*, 212 F 3d 477, 485 (9th Cir 2000) ("The objective-extrinsic test requires analytical dissection of a work and expert testimony ")

In such expert testimony, Ms Vara could have expressed her view as an expert in television production and as a person engaged in the profession of ensuring that her employer avoids infringement, that the degree of similarity between "Heroes" and Plaintiffs' copyrighted works is "unheard of in production [of television series of a major network] and should never have been permitted" by NBCU's "Clearance" department (Appendix B to Petitioners' reply in support of petition for certiorari)

Ms Vara could also have testified about real-life facts that also demonstrate "substantial similarity." In particular, she states that since the running of the "Heroes" television series accused of infringement (with its heroine-addicted "artist that paints the future" to try to warn others), the real-life Plaintiff (who does not use drugs) is now asked in the free lectures he gives to young students whether "they need to shoot heroin to paint the future like the artist on 'Heroes'" Those questions by the young students demonstrates that real-life "lay observers" see the connection between Plaintiffs' "artist that paints the future" and Defendants' "artist that paints the future," further evidence that would have weighed in favor of infringement and against grant of summary judgment Plaintiffs had no fair opportunity to present this, and other evidence and testimony, because of the absence of prior notice that the Rule 12(b)(6) motion was to be converted to a Rule 56 motion for summary judgment

Accordingly, the district court's failure to provide the 10 days notice required by Rule 56(c) prior to conversion of the Rule 12(b)(6) motion to a Rule 56 motion, uncorrected by the Second Circuit Court of Appeals, was serious error, and not harmless, since the

lack of fair notice effectively precluded Plaintiffs from presenting material and relevant evidence that would have been appropriate in opposing a motion for summary judgment and would likely have changed the result This would not have occurred if the mandatory notice required by the Majority of circuits had been applied, rather than the permissive notice of the Second Circuit

This Court may take judicial notice that Rule 12(b)(6) motions are filed in most lawsuits filed in federal court, many of which are accompanied by materials outside the pleadings Thus, the issue of whether the motion may be converted to a Rule 56 motion for summary judgment is routine for all types of cases It is therefore is important to have a nationwide rule

CONCLUSION

For the foregoing reasons, it is respectfully requested that the Supreme Court grant rehearing to resolve this split in the Circuits, in favor of the mandatory notice applied by the Eleventh Circuit

Respectfully submitted,

Theodore F Shiells
Counsel of Record
CARR LLP
900 Jackson Street No 670
Dallas, Texas 75202
(214) 760-3032
tshiells@Carrip com

Counsel for Petitioners
Clifton Mallery a/k/a
Enjai Omaa Eele,
Amnau Karam Eele

CERTIFICATION OF COUNSEL

As required by Supreme Court Rule 44 2, I certify that this Petition for Rehearing of Order Denying Petition for Writ of Certiorari is limited to substantial grounds not previously presented and is presented in good faith and not for delay

May 21, 2010

Theodore F Shiells/mrc
Theodore F Shiells
Counsel of Record
CARR LLP
900 Jackson Street No 670
Dallas, Texas 75202
(214) 760-3032
tshiells@Carrip com

Counsel for Petitioners
Clifton Mallery a/k/a
Enjai Omaa Eele,
Amnau Karam Eele